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Shunpei Yamazaki

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EXAMINER

EHICHIOYA, FRED I

ART UNIT

PAPER NUMBER

2162

MAIL DATE

DELIVERY MODE

09/18/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

09/852,266

Applicant(s)

YAMAZAKI ET AL.

Examiner

Fred I. Ehichioya

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08/072007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 11 - 17, 29, 30, 32, 33, 35, 36, 38, 39, 41, 42, 44, 45, 47, 48, 50, 51, 53, 54, 66, 67, and 70 - 81 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

Continuation of Disposition of Claims: Claims pending in the application are 11 - 17, 29, 30, 32, 33, 35, 36, 38, 39, 41, 42, 44, 45, 47, 48, 50, 51, 53, 54, 66, 67, and 70 - 81.

## DETAILED ACTION

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on August 7, 2007 has been entered.
2. Claims 11- 17, 29, 30, 32, 33, 35, 36, 38, 39, 41, 42, 44, 45, 47, 48, 50, 51, 53, 54, 66, 67 and 70 – 81 are pending in this Office Action.

### ***Response to Arguments***

3. Applicant's arguments, see Remark/Argument, filed July 6, 2006, with respect to claims 70 – 72 rejected under 35 U.S.C. 101 have been fully considered and are persuasive. Therefor, rejection of claims 70 – 72 rejected under 35 U.S.C. 101 of last Office Action has been withdrawn.
4. Applicant argues:
  - (a) ***Neither Uchida, Fakuzumi, nor any proper combination of the two describes or suggests sending a password as a data to a mating party (or a manager) after authentication end signal is sent to the mating party (or manager), and transmitting a re-write approval signal having information representing approval of re-write of reference living body information from mating party (or the***

***manager) when the password is authenticated as correct on the mating parting (or manager) (page 12, paragraph 1).***

Examiner respectfully disagrees with the applicants. APA (Applicant admitted prior art) discloses, "sending a password as a data to a mating party (or a manager) after authentication end signal is sent to the mating party (or manager) as shown on (Page 2, line 2 - 5);

Uchida discloses storing living body information (see page 20, lines 13 – 17), Fukuzumi discloses collating living body information (see column 6, lines 6 – 8); and

APA discloses transmitting a re-write approval signal having information representing approval of re-write of reference living body information from mating party (or the manager when the password is authenticated as correct on the mating parting (or manager) (see page 2, lines 11 – 16).

### ***Objections to Drawings***

5. The drawings are objected to because Figs. 7, 8 and 12 do not have legend or labels. Suitable descriptive legends may be used subject to approval by the Office, or may be required by the examiner where necessary for understanding of the drawing. They should contain as few words as possible (37 CFR 1.84(o)).

***Claim Rejections - 35 USC § 101***

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 11 – 17, 29, 30, 32, 33, 35, 36, 38, 39, 41, 42, 44, 45, 47, 48, 50, 51, 53, 54, 66 and 67 are rejected under 35 U.S.C. 101 because:

Claims 11 and 17 are directed to a “communication system”; Applicant discloses on page 1, lines 5 - 6 of the specification “a communication system for executing authentication (identifying) by using living body information (biological information)”; page 13, lines 10 – 11 of the specification discloses “Fig.1 is a flowchart showing a processing of a communication system”. However, drawing Fig.1 discloses “communication” and does not reflect a communication system. Applicant further states on page 2, lines 17 – 18 that the term “communication” means “transmission/reception of intended information”; this is software per se (MPEP 2106.01 [R-5] (I)).

Regarding claims 16, 29, 32, 35, 38, 41, 44, 47, 50, 53, 66 and 30, 33, 36, 39, 42, 45, 48, 51, 54, 67; they depend from claims 11 and 17 respectively, recite computing steps, merely descriptive and lack the necessary physical articles or objects to constitute a machine or a manufacture within the meaning of 35 USC 101 and therefore non-statutory.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 11 – 17, 29, 30, 32, 33, 35, 36, 44, 45, 5, 51, 53, 54, 66, 67, and 70 - 81 are rejected under 35 U.S.C. 103(a) as being unpatentable over UK Patent Appl. No. GB 2348309 issued to Kaoru Uchida (hereinafter "Uchida") in view of USPN 6,144,757 issued to Shinichi Fukuzumi et al (hereinafter "Fukuzumi") and further in view of Applicant Admitted Prior Art (hereinafter "APA").

Regarding claims 11 and 17, Uchida teaches a communication system for distinguishing a user, said system comprising:

a storing means for storing reference living body information (see page 20, lines 13 – 17; Uchida discloses “fingerprint” as “living body”);

Uchida does not explicitly collation and a collating means as claimed.

Fukuzumi discloses a reading means for reading collating living body information of the user (column 9, lines 29 – 32: “bioelectric signal identification section” is interprets “unit 12” as “reading means”; and “output” is interpreted as “read”); and

collating means for collating the collation living body information with the reference living body information (column 6, lines 6 – 8);

Further, APA discloses a sending means for sending the authentication end signal to a mating party (see spec. page 2, lines 3 - 5);

wherein a password is sent as data to the mating party/manager after the authentication end signal is sent to a mating party (see spec. page 2, lines 11 – 13), and

wherein a re-write approval signal having information representing approval of re-write of the reference living body information is transmitted from the mating party when the password is authenticated as correct on the mating party (see spec. page 2, lines 11 – 16 “the mating party send a collation end signal representative of authentication approval/rejection as information as data to the user. . . . When the user is authenticate, the authentication operation is finished at the point when the user receives the collation end signal”), and

wherein the reference living body information is written after the user receives the re-write approval signal from the mating party (Applicant discloses on page 5, lines 15 – 17 that living body is re-written when password proves coincident; therefore, APA



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discloses re-writing living body information since it was disclosed (see spec. page 2, lines 6 – 9) that “the user is authenticated when the password coincide”)

It would have been obvious to one of ordinary skill in the data processing art at the time of the present invention to combine teaching of the cited references because Fukuzumi’s teaching of “collation” would have allowed Uchida’s system to provide an organism identification method that can securely identify whether or not a fingerprint image input object relates to a living body.

Further, the teaching of APA would have allowed Uchida and Fukuzumi’s system prevent a third party other than the authentic person from communicating as the user with mating party under the disguise of the authentic person as suggested by APA (spec. page 2, lines 20 – 25).

Regarding claim 12, Uchida, Fukuzumi and APA disclose the claimed subject matter as discussed in claim 11.

Uchida teaches a wherein the reference living body information comprises n reference living body information (see page 20, lines 13 – 17), and the sending means sends the authentication end signal to a mating party to the mating party when all of collation results prove coincident (see page 32, lines 13 - 16).

Further Fukuzumi discloses the collation living body information of the user comprises n collation living body information of the user (column 6, lines 29 – 32), the collating means collates the n collation living body information with the n reference living body information (page 8, lines 15 – 24).

Regarding claim 13, Uchida, Fukuzumi and APA disclose the claimed subject matter as discussed in claim 11.

Uchida teaches wherein the reference living body information comprises n reference living body information and the sending means sends the authentication end signal to a mating party (see page 32, lines 13 – 16) when at least one of the n reference living body information coincides with at least one of the m collation living body information (see page 21, lines 22 – 27);

Further Fukuzumi discloses the collation living body information of the user (column 6, lines 29 – 32), comprises in collation living body information of the user, the collating means collates the m collation living body information with the n reference living body information (column 7, lines 34 – 38).

Regarding claim 14, Uchida, Fukuzumi and APA disclose the claimed subject matter as discussed in claim 11.

Uchida teaches wherein the reference living body information comprises a plurality of kinds of reference living body information (page 22, lines 23 – 26), and the sending means sends (page 32, lines 13 - 16) the authentication end signal to the mating party when the plurality of kinds of collation living body information wholly coincide with the plurality of kinds of reference living body information (page 23, lines 5 – 10: Examiner interprets “input fingerprint is in accord with the fingerprint feature stored” as “when all of collation results prove coincident”);

Further Fukuzumi discloses the collation living body information of the user comprises a plurality of kinds of collation living body information of the user (column 6, lines 29 – 32), the collating means collates the plurality of kinds of collation living information with a plurality of kinds of the reference living body information body (column 7, lines 34 – 38).

Regarding claim 15, Uchida, Fukuzumi and APA disclose the claimed subject matter as discussed in claim 11.

Uchida teaches wherein the reference living body information comprises n reference living body information of a plurality of kinds (page 22, lines 23 – 26), and the sending means sends (page 32, lines 13 - 16) the authentication end signal to a mating party to the mating party when at least one of each kind of collation living body information among the plurality of kinds of collation living body information coincides with at least one of each kind of reference living body information among the n reference living body information (see page 32, lines 13 – 16).

Further Fukuzumi discloses the collation living body information comprises in collation living body information of a plurality of kinds of a user (column 6, lines 29 – 32), the collating means collates the m collation living body information with the n reference living body information (column 7, lines 34 – 38),

Regarding claim 16, Uchida, Fukuzumi and APA disclose the claimed subject matter as discussed in claim 11.

Fukuzumi teaches wherein the reference living body information comprises n reference living body information of a plurality of kinds, the collation living body information comprises m collation living body information of a plurality of kinds of a user (column 6, lines 29 – 32), the collating means collates the m collation living body information with the n reference living body information (column 7, lines 34 – 38), and the sending means sends the authentication end signal to a mating party (column 6, lines 43 - 46) to the mating party when all of the plurality of kinds of collation living body information coincide with all of the n reference living body information (column 6, lines 29 - 32).

Regarding claim 29 and 30, Uchida teaches wherein the reference living body information comprises at least one selected from the group consisting of a fingerprint, a palm print and a voiceprint (see page 35, lines 7 – 16).

Regarding claims 32 and 33, Uchida teaches wherein the collation living body information comprises at least one selected from the group consisting of a fingerprint, a palm print and a voiceprint (see page 35, lines 7 – 16).

Regarding claim 35, 36, 53 and 54, Uchida teaches wherein the palm print is a palm print of the whole palm or a palm print of a part of the palm (see page 35, lines 7 – 16).

Regarding claims 44 and 45, Uchida teaches a portable information terminal comprising the storing means, the reading means, the collating means, the controlling means, and the sending means is used (see page 35, lines 17 – 22).

Regarding claims 50 and 51, Uchida teaches a personal computer comprising the storing means, the reading means, the collating means, the controlling means, and the sending means is used (see pages 1 - 3).

Regarding claims 66 and 67, Uchida discloses wherein the reading means is a display part having a built-in-sensor (page 18, lines 22 – 27).

Regarding claims 70 and 71, Uchida teaches a method for distinguishing a user, said method comprising:

storing reference living body information of the user (see page 20, lines 13 – 17; Uchida discloses “fingerprint” as “living body”); and

reading a living body information of the user (page 21, lines 17 - 19) so that the reference living body information is rewritten after the receiving the re-write approval signal from the mating party (page 25, lines 7 – 8 – input is interpreted as re-write)

Uchida does not explicitly collation as claimed.

Fukuzumi discloses reading collating living body information of the user a reading means for reading collating living body information of the user (column 9, lines 29 – 32: “bioelectric signal identification section” is interprets “unit 12” as “reading means”; and “output” is interpreted as “read”);

Collating the collation living body information with the stored reference living body information (column 6, lines 6 – 8); and

outputting an authentication end signal from controlling means when a collation result proves coincident (see column 7, lines 35 - 39);

Further, APA discloses sending the authentication end signal to a mating party/manager (see spec. page 2, lines 3 - 5);

sending password as data to the mating party/manager after communication is started (see spec. page 2, lines 11 – 13);

and the reference living body information is rewritten when the password is authenticated as correct on the mating party (page 36, lines 6 - 9).

transmitting a re-write approval signal having information representing approval of re-write of the reference living body from the mating party to the user when the password is authenticated as correct on the mating party (see spec. page 2, lines 11 – 16 “the mating party send a collation end signal representative of authentication approval/rejection as information as data to the user. . . . When the user is authenticate, the authentication operation is finished at the point when the user receives the collation end signal”), and

receiving the re-write approval signal from the mating party/manager (see page 2, lines 15 – 16 – “when the user receives the collation end signal, the communication is then started”).

It would have been obvious to one of ordinary skill in the data processing art at the time of the present invention to combine teaching of the cited references because Fukuzumi’s teaching of “collation” would have allowed Uchida’s system to provide an organism identification method that can securely identify whether or not a fingerprint image input object relates to a living body.

Further, the teaching of APA would have allowed Uchida and Fukuzumi’s system prevent a third party other than the authentic person from communicating as the user with mating party under the disguise of the authentic person as suggested by APA (spec. page 2, lines 20 – 25).

Regarding claim 72, Uchida teaches a method for distinguishing a user, said method comprising:

storing reference living body information of the user (see page 20, lines 13 – 17; Uchida discloses “fingerprint” as “living body”); and

outputting an authentication end signal from controlling means (page 36, lines 7 – 9 and lines 18 – 20).

Uchida does not explicitly collation as claimed.

Fukuzumi discloses reading collating living body information of the user (column 9, lines 29 – 32: “output” is interpreted as “read”);

collating the collation living body information with the stored reference living body information (column 6, lines 6 – 8).

Further APA discloses sending the authentication end signal to a manager (see spec. page 2, lines 4 – 5; “the user then transmits a password such as password number as data for authentication to the mating party” – mating party and manager are interchangeably used);

Sending the authentication end signal to a mating party (see spec. page 2, lines 13 – 14; “the user again transmits the password as the data to the mating party); and

wherein a communication between the user and a mating party is started directly through the manager after the mating party receives the authentication end signal (see spec. page 2, lines 2 – 8; APA discloses communication as transmission/reception page 2, lines 17- 18)

It would have been obvious to one of ordinary skill in the data processing art at the time of the present invention to combine teaching of the cited references because Fukuzumi’s teaching of “collation” would have allowed Uchida’s system to provide an organism identification method that can securely identify whether or not a fingerprint image input object relates to a living body.

Further, the teaching of APA would have allowed Uchida and Fukuzumi’s system prevent a third party other than the authentic person from communicating as the user with mating party under the disguise of the authentic person as suggested by APA (spec. page 2, lines 20 – 25).



Regarding claim 73, Uchida teaches wherein a communication between the user and a mating party is started directly through the manager after the mating party receives the authentication end signal (page 4, lines 19 - 20).

Regarding claims 74, Uchida discloses wherein the manager sends the authentication end signal to the mating party after the manager receives the authentication end signal (page 4, lines 27 - 52).

Regarding claim 75, Uchida discloses wherein the manager sends the authentication end signal to the mating party after the manager receives the authentication end signal (page 4, lines 27 - 52), and

wherein a communication between the user and a mating party is directly after the mating party receives the authentication end signal (page 4, lines 19 - 20).

Regarding claims 76, 77 and 78, Uchida discloses wherein a transaction is conducted between the user and the mating party (page 4, lines 18 - 20), and

Wherein an identification of the user is requested only when a condition set to the mating party is satisfied (page 34, line 25 - page 35, line 5).

Regarding claims 79, 80 and 81, Uchida, Fukuzumi and APA disclose the claimed subject matter as discussed in claim 70, 71 and 72 respectively.

Uchida teaches wherein the reference living body information comprises at least one selected from the group consisting of a fingerprint, a palm print and a voiceprint (see page 35, lines 7 – 16), and

wherein the collation living body information comprises at least one selected from the group consisting of a fingerprint, a palm print and a voiceprint (see page 35, lines 7 – 16).

9. Claims 38, 39, 41, 42, 47 and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Uchida in view of Fukuzumi as discussed in independent claims 1, 7, 11, 17 and further in view of APA and USPN 6,219,793 issued to Yang Li et al (hereinafter “Li”).

Regarding claims 38 and 39, Uchida, Fukuzumi and APA disclose the claimed subject matter as discussed in 11 and 17 respectively. Uchida, Fukuzumi or APA does not explicitly teach a flash memory.

Li teaches the storing means is a flash memory (column 12, lines 20 – 27).

It would have been obvious to one of ordinary skill in the data processing art at the time of the present invention to combine teaching of the cited references because Li’s teaching of “storing means is a flash memory” would have allowed Uchida, Fukuzumi and APA’s system to involve the use of fingerprint matching to authenticate a call or other communication over a wireless communication network as suggested by Li at column 3, lines 10 - 12.

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Regarding claims 41 and 42, Li teaches the reading means is a photodiode or a charge coupled device (see column 4, lines 50 – 65).

Regarding claims 47 and 48, Li teaches a cellular telephone comprising storing means, the reading means, collating means, the controlling means, and the sending means is used (see column 4, lines 33 – 49).

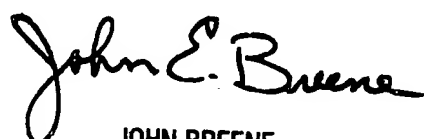
**Conclusion**

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fred I. Ehichioya whose telephone number is 571-272-4034. The examiner can normally be reached on M - F 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John E. Breene can be reached on 571-272-4107. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Fred I. Ehichioya  
Patent Examiner  
Art Unit 2162  
September 10, 2007



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